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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,523	11/02/2001	Mark Freier	3401-125	4169

7590 02/23/2005

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EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/002,523	<b>Applicant(s)</b> FREIER ET AL.	
	<b>Examiner</b> Michael Thaler	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Feb. 3, 2005 has been entered.

The disclosure is objected to because of the following informalities: The brief description of figure 4 should be deleted since the figure itself was deleted. On page 5, line 21 of the original disclosure, "3" is incorrect. The text on page 6, lines 13-15 is unclear since it indicates that sleeve 13 is screwed onto sleeve 12 while figure 3 shows sleeves 12 and 13 as being unitary with each other. Appropriate correction is required.

Claims 8-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not seen how covering 7 can have a circumferential shape which corresponds to

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the circumferential shape of trough 5 (as described on page 5, lines 9-12 of the original disclosure) and still bend upwards when pushed distally as shown in figure 2. Although a flat strip may bend as shown in figure 2, a strip which is curved in cross-section would not appear to be able to so bend.

Claims 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heaven et al. (5,318,528) in view of Falk et al. (4,569,131). Heaven et al. disclose hollow shank 2, scoop (the lower jaw 5 as viewed in figures 4 and 5) which defines a spoon-shaped trough having an opening (at the top of the trough) and a closed end (at the left or bottom of the trough) handling means (at the proximal end of shaft 2) and having an actuation mechanism (the mechanism, not shown in the drawings, which opens and closes the upper jaw 5), actuating rod 6 and covering (the upper jaw 5). Heaven et al. fail to disclose the actuating rod being releasably connectable with actuation mechanism. However, Falk et al. teach that the actuation rod 8 of a surgical instrument should be detachable from the actuation mechanism 3 apparently in order to obtain the advantage of enabling the parts to be detached to better sterilize them or to replace them when a part becomes defective. It would have been obvious to make the connection between the actuating rod and the actuation mechanism of the Heaven et al. instrument releasable so that it

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too would have these advantages. As to claim 11, Heaven et al. disclose holding-down device (the pivot pin upon which the upper jaw 5 pivots) which holds jaw 5 onto the rest of the instrument and which guides the jaw and holds it closed since it holds the jaw 5 in position. As to claim 12, the edge is at an angle relative to a longitudinal axis of the hollow shank 2 (i.e. the main portion hollow shank 2) as seen in figure 6. As to claim 13, the claimed covering may be considered to be the combination of the upper jaw 5 and cover 7. This covering is made of elastic material since portion 7 is elastic. As to claims 15 and 16, the volume defined by the scoop is separated from a volume defined by the hollow shank 2.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's arguments with respect to claims 8-16 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can

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be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

mht  
2/17/05



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731